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Paper No. 20
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Airlines, Inc.

Serial No. 75/484,640

Kay Lyn Schwartz of Gardere Wynne Sewell, LLP for American Airlines, Inc.

Ellen Awrich, Trademark Examining Attorney, Law Office 113.

Before Cissel, Seeherman and Wendel, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On May 13, 1998, applicant filed the above-referenced application to register the mark "INVENTORY SUPPORT INTERNATIONAL" on the Principal Register for what were subsequently identified as "retail stores featuring new, used and refurbished airplane parts," in Class 35; and "storage of airplane parts," in Class 39¹. The basis for

¹ Although the application, as filed, also included "wholesale distributorship services featuring new, used and refurbished airplane parts" in the recitation of services, the above-referenced recitation is the way the services were recited in the amendment to allege use. Even though the amendment to allege use

filing the application was applicant's claim that it possessed a bona fide intention to use the mark in commerce in connection with the services identified in the application.

The Examining Attorney finally refused registration under Section 2(e)(1) of the Lanham Act on the ground that the mark is merely descriptive of the services with which applicant intends to use it. Applicant timely filed a Notice of Appeal. Both applicant and the Examining Attorney filed briefs on appeal, and applicant filed a reply brief², but applicant did not request an oral hearing before the Board.

was subsequently withdrawn, both the applicant and the Examining Attorney proceeded on the assumption that the application had been amended to recite the services in this fashion. Accordingly, we deem the recitation to have been amended to adopt this language. Additionally, we note that we are treating the recitation of services in Class 35 as if "retail stores" had been amended to adopt the preferred wording "retail store services." "Stores" are not services, but we will not remand the application to the Examining Attorney at this late stage of the process for the correction of this minor problem. If, however, applicant were ultimately to prevail on appeal from our decision, applicant should file an amendment to use the term "store services."

² In its reply brief, applicant objects to the argument, presented by the Examining Attorney for the first time in her appeal brief, that applicant's disclaimer of the term "INVENTORY SUPPORT, INC." in the prior registration claimed by applicant is evidence of the descriptiveness of the term "INVENTORY SUPPORT" in connection with the services set forth in that registration as well as this application. Applicant argues that raising this argument for the first time in the appeal brief left applicant without the opportunity to address it. Obviously, applicant did have the opportunity to respond to this argument, and did so, in its reply brief. Rather than respond on the merits, however, its

In support of her refusal to register, the Examining Attorney made of record dictionary definitions³ of the word "inventory" as "a detailed, itemized list, report, or record of things in one's possession, especially a periodic survey of all the goods and materials in stock..."; of the word "support" as "to provide for or maintain, by supplying with money or necessities..."; and of the word "international" as "extending across or transcending national boundaries: international fame." She took the position that applicant's mark is merely descriptive of the services specified in the application because those services encompass providing inventory support internationally, i.e., making available a stock of goods and materials in the form of airplane parts, for customers in different countries.

response was to claim that it had not had the opportunity to respond.

The argument to which applicant objects did not raise a new issue after the institution of the appeal. Instead, the argument made by the Examining Attorney in her brief was directed to the issue of whether the mark is descriptive of the services set forth in the application, which had been an issue since the first Office Action, wherein registration was refused under Section 2(e)(1). Whereas it would not have been proper to raise a new issue in the Examining Attorney's brief, it was not improper to make an additional argument there in support of the refusal to register which applicant had appealed. Applicant's objection is accordingly overruled.

³ From The American Heritage Dictionary of the English language, third edition, 1992, Houghton Mifflin Company, electronic version.

In support of the refusal, she also attached a representative sampling of 20 of the 725 excerpts from published articles she had retrieved from the Nexis database of publications. The excerpts show that the term "inventory support," is a recognized business term. For example, one excerpt states that "...distributors can also provide important inventory support..."; another notes that a "...company provides broad-based inventory support to a range of customers..."

The Examining Attorney takes the position that the word "INTERNATIONAL" is merely descriptive of the international scope of applicant's inventory support services, such that the composite mark "INVENTORY SUPPORT INTERNATIONAL," considered in its entirety, would immediately inform prospective customers, in this case airlines and other business entities which need airplane parts for the maintenance and repair of airplanes, that applicant's store services featuring its inventory of airplane parts and applicant's services of storing inventories of airplane parts owned by others are both international in scope.

The test for determining whether a mark is unregistrable under Section 2(e)(1) of the Lanham Act is well settled. A mark may be refused registration under

this section if it immediately and forthwith conveys information about a significant characteristic, feature, function, purpose or use of the goods or services identified in the application. In re Gyulay, 820 F.2d 1216, 4 USPQ2d 1009 (Fed. Cir. 1987); In re MetPath Inc., 223 USPQ 88 (TTAB 1984); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). This determination must be not be made in the abstract, but rather only in consideration of the goods or services set forth in the application. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Thus, the test is not whether one could surmise from consideration of the mark by itself what the goods or services are or what their significant characteristics are. In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

Based on careful consideration of the record and arguments before us in this appeal, as well as the relevant legal precedent on this issue, we hold that the refusal to register is well taken. The evidence of record, namely the definitions of all three of the component words which make up applicant's mark and the excerpts from published articles which use the term "inventory support," establish that "INVENTORY SUPPORT" is an accurate description of what applicant provides for its customers, and that the addition

of the word "INTERNATIONAL" is understood simply as an indication that the scope of applicant's services extends to different countries.

While the particular excerpts from published articles quoted above do not appear to be related to retail store services in the usual sense of that term, it must be remembered that applicant's customers will presumably be airlines and other business which own and maintain their own aircraft, as well as businesses which maintain and repair aircraft for others. Accordingly, the term "retail stores" used in the recitation of services in the application must be accorded a narrower, more specialized meaning than would ordinarily be attributed to the term in the context of ordinary consumer products such as clothing and housewares, for example. In the context of this application, we interpret "retail stores" featuring airplane parts as referring to applicant's making available for inspection and purchase its inventory of new, used and refurbished airplane parts. When the excerpted articles showing use in the press of the term "inventory support" are considered in this context, the descriptive nature of "inventory support" in connection with applicant's services of providing airplane parts and storage for airplane parts is clear.

None of the arguments applicant makes to the contrary is persuasive. Applicant repeatedly contends that the refusal is improper because "...the consumer cannot immediately surmise what services are provided by Applicant." Applicant argues that:

"the mark does not readily convey its meaning to the average purchaser. The Mark INVENTORY SUPPORT INTERNATIONAL brings to mind different ideas of what kind of inventory may be supported and in what way it is supported. One would also ask what kind of international support is being given. Therefore, a multistage reasoning process is required when determining what services are offered by Applicant." (Brief, p. 3).

This line of argument evidences a misunderstanding of the legal test for mere descriptiveness, as described above. As we noted there, the issue is not whether one could guess what the services are from considering the mark by itself, but rather whether the mark conveys to one who is familiar with the services rendered under the mark information concerning the nature of the services or their characteristics or features.

Because of the plain meanings of the word "INTERNATIONAL" in combination with the term "INVENTORY SUPPORT," the relevant consumers would understand that "INVENTORY SUPPORT INTERNATIONAL," in connection with the identified services, indicates that applicant has an international operation in which it makes its inventory

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available for retail purchase and that applicant provides storage for airplane parts inventories. This conclusion does not require any mental gymnastics or complex reasoning.

DECISION: The refusal to register under Section 2(e)(1) of the Act is affirmed.

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